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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,445	12/03/2003	Ray F. Barnard	END919990043US2	7109
7590 02/03/2006			EXAMINER	
Shelley M. Beckstrand Patent Attorney 61 Glenmont Road Woodlawn, VA 24381-1341			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	
DATE MAILED: 02/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,445

Applicant(s)

BARNARD ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,9 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,9 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This non-final Office action is responsive to Applicant's election filed November 9, 2005.

Applicant has elected Group I (claims 8, 9, and 13-16) with traverse.

Claims 17-19 stand as non-elected.

Claims 8, 9, and 13-16 are presented for examination.

Response to Arguments

2. Applicant's arguments filed November 9, 2005 have been fully considered but they are not persuasive.

Applicant traverses the restriction requirement on the grounds that all three groups are classified in 705/10 and, therefore, do not pose a serious burden to the Examiner to search. The Examiner respectfully disagrees. Even though all three groups are classified in 705/10, each of the groups is directed toward divergent subject matter, thereby requiring a different search strategy for each. Consequently, the Examiner submits that searching all groups would present a serious burden to the Examiner and, therefore, the restriction requirement is maintained.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8, 9, and 13-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 9 recite that the database is "for coordinating tasks by a plurality of enterprise teams implementing said procedures, said procedures including..." and then list various procedures. It is not clear if Applicant intends that the performance of these procedures be expressly recited. In other words, are the templates describing these procedures merely made available or are the metes and bounds intended to require that each of the listed procedures actively be carried out by the enterprise teams? As recited, since the procedures define the types of templates available, they are nothing more than non-functional, descriptive material (which does not merit patentable weight).

Additionally, claim 9 recites various occurrences of "including any..." Is this phrase equivalent to "at least one of the following"? If there are no requirements that at least one of the listed options be assessed, then is the list of options ignored?

Claims 13-16 recite limitations that invoke the same rejections applied to claims 8 and 9; therefore, the same rejections apply.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8, 9, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gundewar et al. (U.S. Patent No. 6,381,610).

Gundewar discloses a web-enabled, enterprise team integrated process for assessing a project, including:

[Claim 8] maintaining a database of templates describing procedures for assessing said project (Fig. 1; col. 4, lines 15-51; col. 6, lines 60-64);

operating a plurality of web-enabled user terminals to access via a server said database for coordinating tasks by a plurality of enterprise teams implementing said procedures (Fig. 1; col. 3, lines 16-17; col. 4, lines 15-51; col. 6, lines 60-64).

As per claims 8 and 9, Gundewar does not expressly teach the types of procedures recited; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. Therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

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Nevertheless, the Examiner submits that the recited procedures are merely old and well-known examples of consulting functions, including gap analysis. Gundewar is directed toward project planning, which is a major component of improving many business operations; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Gundewar's template to assist in general, well-known consulting practices (such as the procedures recited throughout claims 8 and 9) in order to make these templates more versatile and useful for a wider range of consulting functions, thereby making this template software more marketable.

While Gundewar discloses that the stored and created templates are used for project management applications, Gundewar fails to expressly teach that the specific type of project management applications include a general procurement and accounts payable application. However, these limitations merely recite various intended uses of the invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The claimed recitations of intended use neither result in a structural difference between the claimed invention and the prior art nor in a manipulative difference as compared to the prior art; therefore, the claimed

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invention is not deemed to be patentably distinct over the prior art. Furthermore, the Examiner submits that general procurement and accounts payable applications are commonly utilized as part of project management planning. For example, many projects are limited by constraints related to costs, including accounts payable, and the ability to obtain needed resources, i.e., general procurement. In order to more fully understand the limitations imposed on a project as a whole and the likelihood of achieving project goals, a more comprehensive analysis of all factors affecting the project is required. Since Gundewar is already directed toward project management and therefore suggests the incorporation of factors related to project management, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Gundewar to include a general procurement and accounts payable application as part of its project management templates system in order to assist users involved with the planning of a particular project in more fully understanding the limitations imposed on a project as a whole and the likelihood of achieving project goals, thereby yielding a more comprehensive analysis of all factors affecting the project.

[Claims 13-16] Claims 13-16 recite limitations already addressed by the rejection of claims 8 and 9 above; therefore, the same rejection applies.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

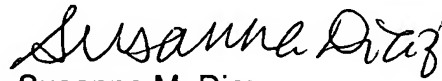
Feurer et al. -- Discloses performance measurement systems for evaluating the performance of an organization.

Davis et al. -- Discloses typical approaches to consulting from a consultant's point of view.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susanna M. Diaz
Primary Examiner
Art Unit 3623

January 23, 2006